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William J. McGinnis, Jr. IBM Corporation, Dept. 917 3605 Highway 52 North Rochester, MN 55901-7829			EXAMINER LIN, SHEW FEN	
			ART UNIT 2166	PAPER NUMBER

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/600,014	Applicant(s) CHATTERJEE ET AL.	
	Examiner Shew-Fen Lin	Art Unit 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/20/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Detail Action

- a. This action is responsive to communications: application filed on 6/20/2003, IDS filed on 6/20/03.
- b. Claims 1-28 are pending in this Office Action. Claims 1, 7, 12, 18, and 21 are independent claims.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

“memory 133” in paragraph [0048], lines 3 and 7, paragraph [0049], line 2.

“134” in paragraph [0048], line 4.

“annotation plug-ins 122” in paragraph [0055], line 2.

“an annotation browser 126” in paragraph [0056], line 1.

“the annotation browser 128” in paragraph [00106], line 4.

“Annotations buttons 802 and 804”, in paragraph [00110], line 3.

“pull down menu 812” in paragraph [00113], line 4.

“check boxes 712_B” in paragraph [00114], line 6.

“text box 714_B” in paragraph [00114], line 6.

“check boxes 714_C” in paragraph [00115], line 5.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the Figures appearing on the immediate prior version of the sheet, even if only one Figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: paragraph [0027]. The paragraph is a redundancy of paragraph [0025].

Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re*

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Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12, 18, and 21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15, 25, and 28 of **Co-pending Application No. 10/600014**. Although the conflicting claim is not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations.

Claims 15, 25, and 28 of the **10/600014** recites all the elements of claims 12, 18, and 21 of the instant application and as such anticipates claims 12, 18, and 21 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus)." *ELI LILLY AND COMPANY v BARR LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

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Claim 21 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of **Co-pending Application No. 10/600390**. Although the conflicting claim is not identical, they are not patentably distinct from each other because they are substantially similar in scope and they use the same limitations.

Claim 25 of the **10/600390** recites all the elements of claim 21 of the instant application. Claim 25 of the **10/600390** also includes additional elements that are not recited in the instant claim. For example, a browser application.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to omit the additional elements “**a browser application configured to browse annotations in the annotation store.**” of claim 25 to arrive at the claim 21 of the instant application because the person would have realized that the remaining element would perform the same functions as before. “Omission of element and its function in combination is obvious expedient if the remaining elements perform same functions as before.” See *In re Karlson* (CCPA) 136 USPQ 184, decide Jan 16, 1963, Appl. No. 6857, U.S. Court of Customs and Patent Appeals.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 12-24, and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al. (US Patent 6,956,593, hereinafter referred as Gupta).

As to claim 1, Gupta discloses a method for exchanging information between entities on a network comprising:

installing an annotation management system on the network (annotation sever, annotation content store, and annotation meta data store, Figures 1 and 3, column 2, lines 19-20, column 7, lines 11-16);

identifying a plurality of annotatable data objects manipulated by a plurality of applications on the network (select media and point to be annotated, column 2, lines 23-27, column 13, lines 40-51); and

providing, via the annotation management system, one or more interfaces for manipulating annotations for the annotatable data objects (user interface to create/view annotation, Figures 6-22, column 2, lines 20-22).

As to claim 2, Gupta discloses wherein providing one or more interfaces comprises providing at least one interface for creating annotations (Figures 7-11, column 2, lines 39-41, column 14, lines 58-65) and at least one interface for viewing annotations (Figure 16, column 2, lines 39-41, column 19, lines 37-40).

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As to claim 3, Gupta discloses wherein the one or more interfaces comprise at least one graphical user interface (column 11, lines 60-67).

As to claim 4, Gupta discloses wherein the at least one graphical user interface is accessible from within one or more of the applications (column 14, lines 3-13).

As to claim 12, Gupta discloses a method of creating annotations for a plurality of different type data objects (column 1, lines 33-34) manipulated by a plurality of applications, comprising:

receiving a request from one of the applications to create an annotation for a data object identified by a set of parameters (Figures 6-7, column 12, lines 47-50);

selecting, based, at least in part, on the set of identifying parameters, an annotation structure defining one or more annotation fields (select different annotation structure, text, audio, or URL, column 13, lines 25-28);

generating a graphical user interface allowing entry of the one or more annotation fields (Figures 8-10, column 14, lines 58-65, column 15, lines 10-33);

creating an index based on the one or more identifying parameters (unique annotation identifier, Figure 4, item 194, column 9, lines 1-2); and

creating an annotation record comprising the index and information entered, via the graphical user interface, for the one or more annotation fields (add annotation record through GUI, Figures 8-10, column 12, lines 56-59, column 14, lines 40-48).

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As to claim 13, Gupta discloses further comprising storing the annotation record in an annotation store separate from the annotated data object (store in annotation meta store, Figures 1 and 3, column 7, lines 28-39).

As to claim 14, Gupta discloses wherein selecting the annotation structure comprises:
presenting, to a user, a plurality of annotation structures associated with the data object (Figure 7, column 13, lines 25-28); and
receiving, from the user, a selection of one of the plurality of annotation structures (column 15, lines 13-24).

As to claim 15, Gupta discloses further comprising receiving, from the user, a selected role in which the user has chosen to act (selection of annotation set to act, column 12, lines 65-67, column 13, lines 1-5).

As to claim 16, Gupta discloses wherein the plurality of annotation structures presented to the user is dependent on the selected role (annotation server supports access control, column 13, lines 1-5, column 16, lines 1-6).

As to claim 17, Gupta discloses further comprising generating a graphical user interface for displaying the annotation information, wherein the annotation information presented to the user in the graphical user interface is dependent on the selected role (column 16, lines 1-6).

As to claim 18, Gupta discloses a computer-readable medium containing an executable component for managing annotations created for data objects manipulated by one or more applications on a network which, when executed by a processor, performs operations comprising:

receiving a request from one of the applications to create an annotation for a data object (Figures 6-7, column 12, lines 47-50);

selecting, based, at least in part, on a set of parameters identifying the data object or the application, an annotation structure defining one or more annotation fields (select different annotation structure, text, audio, or URL, column 13, lines 25-28);

generating a graphical user interface screen allowing entry of the one or more annotation fields described by the structure (Figures 8-10, column 14, lines 58-65, column 15, lines 10-33);
and

storing an annotation record comprising information entered, via the graphical user interface screen, for the one or more annotation fields in an annotation store separate from the annotated data object (add annotation record through GUI, Figures 8-10, column 12, lines 56-59, column 14, lines 40-48, store in annotation meta store, Figures 1 and 3, column 7, lines 28-39).

As to claim 19, Gupta discloses wherein receiving a request from one of the applications to create an annotation for a data object comprises receiving the request from a plug-in annotation component (interface module could be a plug-in to an application, column 12, lines 3-13).

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As to claim 20, Gupta discloses wherein selection of the annotation structure is based, at least in part, on one or more user credentials (based on access control, column 16, lines 1-6).

As to claim 21, Gupta discloses a system for managing annotations for one or more different type data sources (column 1, lines 33-34) manipulated by a plurality of different type applications, comprising:

- an annotation database for storing annotations separately from the data sources associated with the annotations (Figures 1 and 3, column 7, lines 7-11);

- a set of annotatable data object points defining portions of the data sources associated with the annotations described by the associated annotations (Figure 4, column 7, lines 45-56);

- a set of annotation structures, each defining a set of annotation fields (Figures 8-10, column 14, lines 58-65, column 15, lines 10-33);

- a set of plug-in components, each for interfacing between one or more applications and an annotation server (column 12, lines 3-13); and

- an annotation server configured to receive, via the plug-in components, requests to access annotations for one or more of the annotatable data object points issued by the one or more of the applications running on the client computer (Figures 6-7, column 12, lines 47-50) and generate a graphical user interface screen, based on an annotation structure associated with the one or more of the annotatable data object points, for creating or viewing annotations for the one or more annotatable data object points (Figures 8-10, column 14, lines 58-65, column 15, lines 10-33).

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As to claim 22, Gupta discloses wherein the one or more different type data sources comprise at least text documents and database tables (files in a database, column 3, lines 42-43).

As to claim 23, Gupta discloses wherein the annotatable data object points comprise at least one or more database cells, and one or more portions of text documents (files in a database, column 3, lines 42-43).

As to claim 24, Gupta discloses wherein the one or more different type data sources further comprise at least multimedia files and the annotatable data object points comprise at least an image (column 2, lines 18-23).

As to claim 26, Gupta discloses wherein the annotation server is configured to create annotations with no direct association to any of the annotatable data object points (create annotation through e-mail, column 23, lines 57-63).

As to claim 27, Gupta discloses wherein the annotation server is configured to create annotations associated with more than one of the data sources (annotation entry corresponds to multiple media streams, column 9, lines 26-34).

As to claim 28, Gupta discloses wherein the annotation server is configured to create more than one annotation for a single annotatable data point (column 9, lines 4-9, 15-25).

Claims 7-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Altman (US Pub 2004/0163042).

As to claim 7, Altman discloses a method for exchanging information between entities on a network comprising a plurality of applications configured for manipulating a plurality of different type data objects (managing annotations on a network, paragraph [0038], lines 3-5), the method comprising:

- installing an annotation server on the network (paragraph [0041], lines 17-19);
- installing one or more plug-in components that provide an interface between at least one of the applications and the annotation server (annotation plug-in, paragraph [0041], lines 6-11);
- identifying a plurality of annotatable data objects manipulated by the applications (identify based on ID and location, Figure 6, paragraph [0042], lines 5-15); and
- providing one or more graphical user interfaces, accessible via the plug-in components, for manipulating annotations for the annotatable data objects (create/modify through GUI, Figures 4A-C, paragraph [0040], 3-6, paragraph [0041], lines 6-11, paragraph [0043], lines 11-14)

As to claim 8, Altman discloses wherein:

- the annotation server is installed on a server computer (Figures 3B and 5, paragraph [0044], lines 3-8); and
- the plug-in components and the plurality of applications are installed on one or more client computers (Figures 3B and 5, paragraph [0054], lines 5-11).

As to claim 9, Altman discloses wherein identifying annotatable data objects comprises identifying data sources and data objects contained within the data sources (data source UID and location, paragraph [0042], lines 5-15).

As to claim 10, Altman discloses wherein the one or more graphical user interfaces are configured for creating and viewing annotations for the annotatable data objects (paragraph [0047], [0048], and [0054]).

As to claim 11, Altman discloses wherein at least one of the applications is configured to access the annotation server without a plug-in component (access directly from database query, Figure 6).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta as applied to claim 1 above and further in view of Naser Barghouti, Stephen North ("Improvise – a process modeling interface with multimedia graph diagrams" in Electronic Proceedings of the ACM Workshop on Effective Abstractions in Multimedia: Layout, Presentation, and Interaction In association with ACM Multimedia '95, hereinafter referred as North).

As to claim 5, Gupta discloses the elements of claim 1 as noted above but does not explicitly disclose manipulating annotations for data objects contained in an electrical or mechanical schematic or a flow diagram.

North discloses incorporating multimedia annotation to process flow diagram (page 1, paragraph 3).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Gupta's disclosure to associated multimedia objects: text, images, audio-video recordings to the flow diagram as taught by North for the purpose of providing a

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sophisticated browsing interface for process understanding and training (page 1, paragraph 5, North). The skilled artisan would have been motivated to improve the invention of Gupta per the above such that annotation makes it easy for process analysis and simulation (page 2, paragraph 3, North).

As to claim 6, Gupta discloses the elements of claim 1 as noted above but does not explicitly disclose one or more applications comprise at least one data analysis application.

North discloses incorporating multimedia annotation to process modeling and analysis system (page 1, paragraph 1).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Gupta's disclosure to associated multimedia objects: text, images, audio-video recordings to the flow diagram as taught by North for the purpose of providing a sophisticated browsing interface for process understanding and training (page 1, paragraph 5, North). The skilled artisan would have been motivated to improve the invention of Gupta per the above such that annotation makes it easy for process analysis and simulation (page 2, paragraph 3, North).

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta as applied to claim 21 above and further in view of North.

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As to claim 25, Gupta discloses the elements of claim 21 as noted above but does not explicitly disclose manipulating annotations for data objects contained in an electrical or mechanical schematic or a flow diagram.

North discloses incorporating multimedia annotation to process flow diagram (page 1, paragraph 3).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Gupta's disclosure to associated multimedia objects: text, images, audio-video recordings to the flow diagram as taught by North for the purpose of providing a sophisticated browsing interface for process understanding and training (page 1, paragraph 5, North). The skilled artisan would have been motivated to improve the invention of Gupta per the above such that annotation makes it easy for process analysis and simulation (page 2, paragraph 3, North).

Related Prior Arts

The following list of prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Wynblatt et al., US 6,871,318 B1, "System and Method for Authoring, Distributing and Replaying Derivative Hypermedia Content", (...multimedia based system for authoring, distributing, and replaying derivative hypermedia content).

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- Sodama. US 6,571,295 B1, “Web Page Annotating and Processing”, (..view/add annotation to web documents).
- Barger et al., US 2004/0205545 A1, “Common Annotation Framework”, (...allowing annotations to be created for a variety of different content types and by a variety of different applications, ...application specified annotation can be added).
- Eintracht et al., US 6,687,878 B1, “Synchronizing/updating local client notes with annotations previously made by other clients in a notes database”, (...documents and associated annotations are treated independently from each other. Separate data structures are created for the documents and for the associated annotations).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shew-Fen Lin
Patent Examiner
Art Unit 2166
December 2, 2005


MOHAMMAD ALI
PRIMARY EXAMINER